

REMARKS

In order to expedite prosecution, claims 1-3 have been canceled without prejudice/disclaimer to the subject matter embodied thereby, rendering the § 102 rejection moot, and claim 4 has been rewritten into independent form. The sole remaining rejection is the rejection of claim 4 under § 103 over US Publication '233.

Regarding the § 103 rejection of claim 4, the Examiner merely concludes that it would have been obvious to provide the claimed structural interrelationship of the recited casing and liquid crystal cell "in order to prevent damage to the cell and the light source." It is respectfully submitted that the Examiner's allegation is *per se* improper because the Examiner has not provided any prior art which discloses the claimed feature as required under § 103. The Examiner merely discounts the claimed structure admittedly not disclosed in any of the applied references as allegedly being obvious without support whatsoever from any of the cited prior art. The Examiner is directed to MPEP § 2143.03 under the section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard for establishing obviousness under § 103:

To establish *prima facie* obviousness of a claimed invention, *all* the claim limitations must be taught or suggested *by the prior art*. (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the pending rejection does not "establish *prima facie* obviousness of [the] claimed invention" as recited in claim 4 because the cited prior art fails the "all the claim limitations" standard required under § 103. The Examiner has failed to identify any portions of the cited prior art which allegedly suggest the claimed structure. What the *Examiner* believes to be obvious is irrelevant in determining patentability under § 103.

In this regard, it is respectfully submitted that the Examiner has merely concluded that the claimed invention would have been obvious based on the Examiner's own *opinion*, which is not commensurate with the requirements under § 103. Accordingly, absent any prior art teachings of the specific structure recited in the claims, the pending rejection is necessarily based solely on improper hindsight reasoning using only Applicants' specification as a guide to reconstruct the claimed invention. The "Examiner's opinion" can not be relied on to replace the deficiency of a prior art reference.

If the Examiner intended to take Official Notice that the differences between the present invention and cited prior art are well-known in the art, then pursuant to MPEP § 2144.03, Applicants respectfully traverse such an assertion and request the Examiner to cite a reference in support of his position (*see* second paragraph, last three lines of MPEP § 2144.03, which requires the Examiner to cite a reference in support of his allegation of Official Notice when Applicants traverse). Indeed, only Applicants' specification discloses the claimed structure and the motivation for providing it within the particular combination recited in claim 4.

At best, the Examiner's basis for the rejection amounts to nothing more than a general allegation that one of ordinary skill in the art *can* achieve the claimed invention, which is not a proper standard by which to make a rejection under § 103. The Examiner is directed to MPEP § 2143.03 under the subsection entitled "Fact that References Can Be Combined or Modified is Not Sufficient to Establish *Prima Facie* Obviousness", which sets forth the proper standard:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (*In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990)).

In the instant case, even assuming *arguendo* that the cited prior art can be modified to reach the claimed invention, it is submitted that the "mere fact that [the cited prior art] can be modified ...

does not render the resultant modification obvious" because nowhere does the *prior art* "suggest the desirability of the modification" as set forth by the Examiner.

Moreover, of record, *only* Applicants' specification provides a basis for the Examiner's motivation for making the modification, rendering the Examiner's motivation an exercise of improper hindsight reasoning. Indeed, as described on pages 15-16 of Applicants' specification, in one exemplary embodiment of the present invention, "[t]he casing 9 is frame-shaped, comprising an edge portion 9a and a side portion 9b, and is configured to support the lighting element 20 in a vertical direction by the edge portion 9a and in a horizontal direction by the side portion 9b" and "the opening portion J is sized to be smaller than a crystal liquid cell 111 comprising at least a pair of transparent substrates with a liquid crystal layer interposed therebetween, to allow the cell 111 to be disposed on the edge portion 9a." Accordingly, as described in Applicants' specification, the structure of the "casing" as recited in claim 4 can make it possible to support the light element in the vertical direction by its "edge portion" and set the liquid crystal cell on the "edge portion," while supporting the light element in the horizontal direction. None of the cited prior art recognize or consider such a *multifunctional* "casing" as in the claimed invention, and indeed have no disclosed need or desire for such a casing, let alone suggest the structural configuration needed to enable such multi-functions. Therefore, claim 4 as amended is submitted to be non-obvious over the cited prior art.

Based on the foregoing, it is respectfully submitted that claim 4 is patentable over the cited prior art. Accordingly, it is respectfully requested that this rejection be withdrawn.

**CONCLUSION**

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

Ramyar M. Farid  
Registration No. 46,692

*Reg No. 36,139*

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
Phone: 202.756.8000 RMF:MaM  
Facsimile: 202.756.8087  
**Date: June 16, 2006**

**Please recognize our Customer No. 20277  
as our correspondence address.**